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EXAMINER	
COLE, ELIZABETH M	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/560,068
Filing Date: June 05, 2006
Appellant(s): CREUX ET AL.

Joan N Drew
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/21/10 appealing from the Office action mailed 11/5/09

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: Claims 1-6, 8-20 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief

(6) Examiner's Statement of Grounds of Rejection

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appeal claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20040092379	Lewis	5-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation that the composition is "contains no lithium oxide other than trace impurities". The specification at page 3 states that the composition contains no lithium oxide but that is not the same as "no lithium oxide other than trace impurities".

Claims 1-6,8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by "trace impurities", because it is not clear what values this encompasses.

Claims 1-6, 8-20 are rejected under 35 U.S.C. 102(a) and (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lewis, U.S. Patent application Publication 2004/0092379. Lewis discloses a glass composition for forming into glass fibers comprising SiO_2 in amounts of 49-76 wt percent; Al_2O_3 in amounts of 2-23 weight percent; CaO in amounts of 3-15 weight percent and MgO in amounts of 2-15 weight percent. See paragraph 0042t. The composition can be used to make glass fibers. The amounts anticipate the claimed amounts. The amounts of B_2O_3, TiO_2, Na_2O + K_20, F_2 and Fe_2O_3 are below the maximum values set forth in the claims. See paragraph 0042. Lewis teaches amounts of lithium oxide of 0-9 percent. See paragraph 0042. Since Lewis teaches amounts which encompass the claimed ranges, Lewis also teaches the ranges and ratios set forth in claims 4-6,9-13. Lewis does not disclose the T liquid temperatures, the claimed Young's Modulus, or T log=4. However, since Lewis discloses a glass composition and yarn having the same components present in the same amounts, it is reasonable to expect that the material of Lewis would possess the claimed properties. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA1977).

Claims 1-6 and 8-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 12-15 of copending Application No. 11/722,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims a composition having the overlapping ranges of the same constituents which is useful for making glass fibers and yarns. Although the claims of US '039 include lithium oxide, it is present in amounts of 0.1-0.8 which indicates that the material is substantially free of lithium.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

With regard to the 112 rejections, Appellant argues that the specification teaches that trace impurities may be present in the composition. However, with regard to the 112 1st paragraph rejection, the specification does not discuss what trace impurities would be present or the amounts in which they would be present. The specification does not discuss lithium oxide in the context of trace impurities. Therefore, there is not adequate disclosure of the claimed invention in the specification. The specification states "the molten glass feeding the bushings is obtained from pure batch materials, or more usually, natural batch materials (i.e., those possibly containing trace impurities)." There is nothing in this statement to establish that lithium oxide is known in the art as being one of the trace impurities in the batch material from which the glass is formed, or what values of lithium oxide would be considered to be a trace value. Further, with

regard to the 112 2nd paragraph rejection, the scope of the claims is indefinite, in that it is not clear what values of lithium oxide would be considered acceptable as a trace impurity and what values would be too high. Appellant has not presented any evidence which establishes that lithium oxide is a known trace impurity in the batch glass or establishing what values of lithium oxide would be considered to be trace impurities. The discussion regarding trace amounts in the specification does not refer to lithium oxide or to any general component but refers to the amount of titanium oxide which may be present as an impurity. There is nothing on the record to establish that the values of 0-0.6% that are set forth with regard to titanium dioxide are art recognized values for all trace impurities. Appellant argues that titanium dioxide is not mentioned on page 6 and that the argument that the particular values of 0-06% relates only to titanium dioxide is misplaced. However, page 6 of the specification does not contain any numerical values and simply refers to natural batch materials possibly containing trace impurities as quoted above. The amount of trace impurities or what the trace impurities might be is not set forth any where on page 6 of the specification. Page 4 of the specification specifically states that titanium dioxide can be present as an impurity in amounts of 0.6. The reference to "an impurity" is in the context of a paragraph which states "titanium oxide acts as a viscosity reducer and helps to increase the specific Young's modulus. It may be present as an impurity (its content in the composition is then from 0-0.6%) or it maybe intentionally added". Thus, it is clear that titanium oxide is specifically referred to on page 4. No evidence has been presented to establish that in this art trace impurities

are generally present in amounts of 0 to 0.6% or to establish that lithium oxide is an impurity generally present in the natural batch materials.

With regard to the art rejection, Appellant argues that Lewis does not anticipate or render obvious the claimed invention because Lewis does not teach a composition having the claimed CaO content of 13 to 14.9% as required by each of the independent claims. However, Lewis teaches a range for CaO of 3-15 wt%. A reference is not required to provide a specific example having a value within the claimed range. Appellant argues that there is no teaching in Lewis of the claimed values of 13-14.9. However, the claimed range is fully encompassed by the range taught by Lewis. Teaching values which fully encompass the claimed range is a teaching of the claimed value. If Lewis intended only to employ values which were those shown in the examples, the disclosure of Lewis would have been so limited. Lewis teaches clearly and unequivocally that CaO can be present in 3-15 wt% which fully encompasses the claimed range. Appellant argues that since Lewis employs lower values of CaO in the examples, that Lewis actually teaches away from the claimed range. However, a teaching of a range which fully encompasses the claimed range can in no way be considered a teaching away from the claimed range. The end value of the range of Lewis of 15 wt% is almost identical to the claimed end point of 14.9%. Appellant argues that Lewis provides no motivation to use the claimed amount of 13-14.9 %. However, Lewis anticipates the claimed range. No motivation is required. The reference itself teaches a range which fully encompasses the claimed values.

Appellant argues that in Lewis the fibers are intended to be insulation blankets rather than as reinforcing fibers. However, Lewis teaches the same fibers and teaches that they can be formed into continuous glass strands or yarns. The instant specification at page 6 states that the yarns can be in various forms such as continuous yarns, chopped strands braids, tapes or mats, (page 6, lines 1-4), and equates fibers and yarns, (page 1, line 6). Lewis further teaches that the fibers can be formed into containers having high strength, (see abstract and column 1), and therefore, the fibers of Lewis are reinforcing fibers, in that they would reinforce both the insulation blanket and the containers. . Further, the fibers of Lewis are disclosed as being of high strength and therefore, they are capable of performing the intended use as reinforcing fibers and yarns. No reinforcement values are claimed.

Appellant argues that Lewis does not teach the claimed amount of MgO. The instant claims recite 6-12% MgO. Lewis teaches 1.84-10.5 wt%. Therefore, Lewis does teach the claimed amount of MgO. As set forth above with regard to the amount of CaO, Lewis teaches the claimed values. A reference is useful for all the teachings it contains, not just what is shown in the examples.

Appellant argues that Lewis does not teach the claimed Young's Modulus. However, since Lewis does teach a glass composition for making glass fibers wherein the composition anticipates the claimed composition, it is reasonable to expect that the fibers of Lewis would have the same properties as the instantly claimed fibers. The same materials cannot have different properties. There is a reasonable basis for expecting the fibers of Lewis to have the same properties as the claimed fibers due to

their same composition. The burden is thus shifted to applicant to show that the fibers of Lewis do not have the claimed properties such as Young's Modulus.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1782

Conferees:

/Rena L. Dye/
Supervisory Patent Examiner, Art Unit 1782

/Benjamin L. Utech/

Primary Examiner